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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/658,089

09/09/2003

Mark A. Reiley

10002-701.409

1396

12458 7590 04/28/2011

GMEDELAWARE 2 LLC
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EXAMINER

PRONE, CHRISTOPHER D

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

04/28/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/658,089	Applicant(s) REILEY, MARK A.	
	Examiner CHRISTOPHER D. PRONE	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-18, 33-46, 48 and 50-53 is/are pending in the application.
- 4a) Of the above claim(s) 50-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-18, 33-46 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-12, 14-18, 33-46, 48, and 50-53 are pending.

Claims 50-53 have been withdrawn.

Claims 13, 19-32, 47, and 49 have been cancelled.

Election/Restrictions

The applicant elected Invention I and the species shown in figure 24 without traverse, on 6/12/06.

Specification

The objection to the abstract of the disclosure has been withdrawn.

Claim Rejections - 35 USC § 112

The 112 rejection of claim 48 has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6, 8, 9, 11, 12, 14-16, 33-36, 38-40, 42, 43, 45, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith USPN 5,092,893.

Smith discloses the invention substantially as claimed being a spinal prosthesis assembly comprising a left and right prosthesis bodies 13 and 14, a connector 40, left and right pedicle anchors 15, and left and right artificial facet joint structures 15 comprising a screw having a shaft and a spacer 30 shown best in figures 1 and 2. Smith further discloses that the facet joint structures comprise convex surfaces to allow the joints to articulate. The examiner is interpreting the threaded connections of Smith to be mechanical frictional attachment means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 7, 10, 17, 18, 37, 41, 44, and 48, are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith USPN 5,092,893.

Smith discloses the invention substantially as claimed being described supra. However, Smith does not disclose that the material for making the implant or that the artificial facet joints are attached by adhesive, cement, or a Morse taper.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the connections of Smith with any of the known equivalents within the art including adhesive, cement, or Morse tapers in order to please the operator's preference or to accommodate different characteristics of the implant site. These connections are all well known options that would be interchangeable to one of ordinary skill in the art at the time of invention. See Wall USPN 4,502,161, for example of a bone implant teaching that adhesives and mechanical fasteners are interchangeable.

In regards to claims 48 and 49, it would have been obvious to make the implant of Smith out of the listed materials. The implant materials are well known within the art. For example, see Zang 5,314,486 wherein the prosthesis is fabricated from selected biocompatible materials including titanium, cobalt chrome and may be fastened to the bone by with roughen surface providing a bone in-growth surface medium.

In regards to claim 18, it would have been obvious to include bone growth material within the implant of Smith in order to decrease the healing time. Implant with bone growth materials are well known within the art. For example, see Burton USPN 5,282,863.

Response to Arguments

Applicant's arguments filed 2/25/11 have been fully considered but they are not persuasive. The applicant argues that Smith fails to disclose an implant comprising joint structures that are configured to articulate. This is not persuasive because the language used to define the articulation is extremely broad and is open to numerous reasonable interpretations. One of ordinary skill in the art would recognize that the joint of smith is configured to articulate during the implantation process in order to accommodate for adjustment of the end plates. Additionally depending on the surgeon's intended use for the implant the implant is capable of being loosened to allow for continued articulation or readjustment after implantation.

In order to advance prosecution the applicant is advised to amend the claims to define how the joints articulate with respect to each other and claim that range of motion permitted by the joints.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. PRONE whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday through Fri 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone
Examiner
Art Unit 3738

/Christopher D Prone/

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/CORRINE M MCDERMOTT/

Supervisory Patent Examiner, Art Unit 3738